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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,230	09/21/2000	Hulikunta Prahlad Raghunandan	JP920000220US1	9221

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EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/666,230

Applicant(s)

RAGHUNANDAN, HULIKUNTA
PRAHLAD

Examin r

Bunjob Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 . 6) ☐ Other: _____

DETAILED ACTION

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the Japanese references, which are incorporated in page 7 of applicant specification, have been cited on form PTO-892 by the examiner, they have not been considered.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1, 13 and 24 recite the limitations "the electronic mail header"; "the purpose of identifying"; "the subject"; "the e-mail"; "the said received emails"; "received e-mails"; "the user"; "the email replies". There are insufficient antecedent basis for these limitations in the claims. Application is suggested to maintain consistency of the phases used in the claims to avoid antecedent problems. For example applicant used electronic mails, emails, e-mails, which may or may not refer to the same. The analog limitations, which also appear in all dependent claims and those limitations, which may have been overlooked by the examiner, should also be amended to expedite prosecution.

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5. Regarding claims 1, 6, 13, 18, 24 and 29, the phrase “optionally”; “parameter like” and “if any” render the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by “parameter like”), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).
6. Claims, 1, 6, 8, 13, 18, 20, 24, 29 and 31, the phrase “and/or” renders the claims indefinite, because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
7. Regarding claims 6, 9, 18, 21, 29 and 32, the phrases “e.g.”; “in any combination”; “any one” and “any various similar combination” render the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
8. Regarding claims 8, 20 and 31 recite the limitations “reply sent to R1-S1, - reply received on S1-R2, - reply sent to R2-S2, - reply received on S2-R3”, since there is no teaching of these acronyms, it is not clear what is R1, R2, R3, S1, S2, S3, such languages render the claims indefinite.
9. Regarding claims 11, 23 and 34, recite limitations “using state of art”; “state of practice technique”, “NLP”; “AI” render the claims indefinite.
10. Applicant is suggested that it is an applicant duty to present the claims’ language is such clear, concise and particular point out the subject matter sought to be patented. For the examination purpose, those ambiguity, which is not clear whether it is required would be interpreted as they are optionally and not required.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-2, 7, 9-14, 19, 21-25, 30 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable by Buskirk, Jr. et al. (U.S. 6,424,997) and Merriam (U.S. 6,609,138).

13. Claims 1, 10, 13 and 24, Buskirk discloses the invention substantially, as claimed, including a method, apparatus and computer program (hereinafter referred to as "system") to handle large volume of e-mail received from a plurality of senders intelligently, by automatically processing each email based on a pre-determined classification system and stored information, said method comprising the steps of: receiving and sending the electronic mails, parsing the electronic mail header to capture keywords for the purpose of identifying the sender, the subject and specific keywords, parsing the electronic mail body, for keywords for purpose of categorizing the e-mail for response, storing the said received emails in a personalized email database (PED), using an expert system for analyzing the emails stored in the PED for identifying co-relations among received e-mails and preparing replies, preparing a reply template using a reply template generator (RTG) and storing reply mails in personal email database (Machine learning based electronic mail system, abstract; using expert system for parsing and classifying e-mail, Col. 1, lines 52-64; morphological analysis, which inherent defining keyword or configuring expert system, Col. 2, lines 14-23; Col. 3, lines 53-64; selecting or generating template, Fig. 2, Col. 4, lines 1936).

Buskirk does not explicitly disclose configuring personal database. However, Merriam teaches e-mail list archiving system, which includes a capability of allowing e-mail administrator to configure its e-mail database allowing the e-mail administrator to perform various tasks associated with the e-mails stored in its database, including archiving the e-mails (Col. 1, line 59-Col. 2, line 30), which in light of applicant specification is equivalent to configuring personal e-mail database.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Buskirk's teaching with Merriam's archiving e-mail capability, with the motivation of enhancing e-mail security and controlling a massive amount of e-mails, which would simplify and enable e-mail processing, expeditiously (Col. 2, lines 19-30).

14. Claims 2, 14 and 25, Buskirk-Merriam discloses the invention substantially, as claimed, including a typical e-mail system, which stored the e-mails in corresponding user mail-boxes in a database (Buskirk, Col. 1, lines 23-32; POP3, Merriam, Col. 1, lines 29-58). In addition, Buskirk-Merriam teaches, the analysis module for analyzing incoming e-mails at the same location, which infer that the analysis result has to store at the same location, e.g., at the same database in the e-mail server (Col. 3, lines 16-35).

15. Claims 7, 19 and 30, as aforementioned in claim 1 above, Buskirk-Merriam discloses generating and providing reply templates to users based on e-mails classification (Buskirk, Col. 4, lines 24-27). Hence, searching reply templates and displaying them on a computer screen are inherent.

16. Claims 9, 12, 21, 23, 32 and 34, Buskirk-Merriam discloses the invention substantially, as claimed, including capable of analyzing text in any part of e-mail messages (Buskirk, Col. 4,

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line 50-Col. 5, line 13). Thus, applying Buskirk-Merriam's teaching to analyze, e-mail of the same subject, the same sender and same subject or the same subject and same recipients or searching any correlating as recited in claims 12, 23 and 34, would have been obvious to one of ordinary skill in the art at the time of the invention was made that was a matter of application-implementation choice.

17. Claims 11, 22 and 33, Buskirk-Merriam discloses the used of expert system for analysis and classifying e-mails (Buskirk, Col. 1, line52-Col. 2, line23), i.e., generating correlations and new associations by said ES using state of art and state of the practice techniques of NLP, AI, machine learning.

18. Claims 3-5, 15-17 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable by Buskirk-Merriam, as applied to claims 1, 14 and 24, and further in view of Smith et al. (U.S. 6,643,462).

19. Claims 3-5, 15-17 and 26-28, Buskirk-Merriam discloses the invention substantially, as claimed, but fails to include storage of personal data profile of the user, calendar, current job contents in personal database, for usefulness to a traveler through an appropriate portable device. However, such concept is not a novel idea, Smith, in an analogous art, teaches, an automate deliver messages and processing of message responses, which intended for using with a travelling user with an appropriate personal mobile device (Col. 1, lines 18-45). The system further includes using of conventional personal assistant software, i.e., Microsoft Outlook in an e-mail sever, which allows each individual client to store his or her profile, calendar, scheduling, task and other personal information in a database if the server (Fig. 18-22).

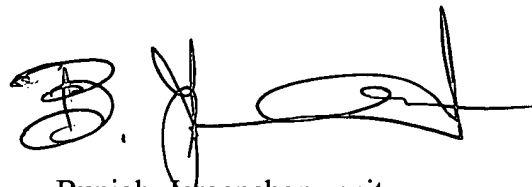
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Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to expand Buskirk-Merriam's utility by including personal profile, and appropriated mobile device, as taught by Smith, with the motivation of allowing the user to specify message processing as desirable (Col. 2, lines 5-60).

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

A handwritten signature in black ink, appearing to read 'Bunjob Jaroenchonwanit', with a stylized, cursive script.

Bunjob Jaroenchonwanit
Primary Examiner
Art Unit 2143

/bj
1/6/04